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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/429,446	10/28/1999	LYNDON W. GRAHAM	SEM4492P0771	5945

26389 7590 11/21/2002

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EXAMINER

LEADER, WILLIAM T

ART UNIT	PAPER NUMBER
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1741

DATE MAILED: 11/21/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/429,446

Applicant(s)

GRAHAM ET AL.

Examiner

William T. Leader

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--Th MAILING DATE of this communication appears on th cover sheet with the correspondence address --

THE REPLY FILED 13 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 15-34

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: See the attached comments.

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Applicant's proposed amendment has been entered. By this amendment, applicant has removed the claim for priority under 35 U.S.C. §120 based on U.S. Application 09/880,715 which was filed subsequent to the October 28, 1999, filing date of the instant application.

At page 2 of applicant's response, applicant states that it is applicant's view that the Examiner should have considered applicant's arguments and specifically addressed whether claiming the benefit of prior U.S. Application 09/018,783 and U.S. Application 08/988,333 mandated that the outstanding rejections should be withdrawn. At page 3 applicant continues by stating that it appears the Examiner focused on the improper cross-reference to co-pending U.S. Application 09/880,715 and concluded that since this cross-reference was improper, that the cross-reference to the other two applications was also improper, and that the present application was not entitled to the earlier filing dates of U.S. Application 09/018, 783 and U.S. Application 08/988,333.

At page 3 of the previous office action, in the section entitled "Response to Arguments" it was stated that "Applicant's Remarks have been carefully considered but are not deemed to be persuasive." Reference was made to all three prior applications on which applicant based the claim for priority under 35 U.S.C. §120. Page 4 of the previous office action set forth the wording of 35 U.S.C. §120 and concluded that the rejections based on the references were proper.

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For convenience the first sentence of 35 U.S.C. §120 is reproduced below.

35 U.S.C. 120. Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

As discussed in section 201.11 of the MPEP, there are six conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 or under 35 U.S.C. 119(e). The first is that the second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the first application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Prods., Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Instant independent claim 15 is directed to a method for electroplating a noble metal into submicron features on a surface of a microelectronic workpiece. U.S. Application 08/988, 333 has matured into patent 5,985,126, and is directed to a

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semiconductor plating system workpiece support having workpiece engaging electrodes with a distal contact part and a dielectric cover . A computer search indicated that none of the terms “noble metal” or “noble metals”, or even the broader term “noble”, appear in the text of the patent. U. S. Application 09/018,783 is directed to a method and apparatus for low temperature annealing of metallization of micro-structures in the production of a microelectronic device. The application as originally filed disclosed the electrodeposition of copper, but did not discuss the electroplating of noble metals. Thus, the subject matter of the instant claims, i.e., electroplating a noble metal into submicron features on a surface of a microelectronic workpiece, is not disclosed in the manner provided by the first paragraph of 35 U.S.C. §112 as required by 35 U.S.C. §120 in either of the prior applications from which benefit is claimed by applicant.

Applicant's Remarks of August 27, 2002, primarily discussed U. S. Application 09/880,715. The Remarks did not include any discussion of disclosure of the presently claimed invention in U. S. Application 09/018,783 or U. S. Application 09/988,333.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Leader, whose telephone number is (703) 308-2530. The examiner can normally be reached Mondays-Thursdays and every other Friday from 7:30 AM to 4:00 PM eastern time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached at (703) 308-3322. The fax phone number for *official* after final faxes is (703) 872-9311. The fax phone number for all other *official* faxes is (703) 872-9310. Unofficial communications to the Examiner should be faxed to (703) 305-7719.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0661.

WL

William Leader:wtl
November 19, 2002


NAM NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700